

REMARKS

The present amendment is submitted in response to the Office Action dated July 25, 2003, which set a three-month period for response, making this amendment due by October 25, 2003. (The period for response was restarted in the July 25, 2003 Office Action, after issuance of the substantive Office Action dated June 23, 2003.

Claims 1-18 are pending in this application.

In the Office Action, claims 1-12 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over either Applicants' Statement or Wong, and further in view of Pet et al, and further in view of Deutsch et al.

The Applicants note with appreciation the indicated allowability of claims 16-18, if rewritten in independent form to include the limitations of the base claim and any intervening claims.

In view of the allowability of claims 16-18, the Applicants have added new claims 19 and 20, which are claims 16 and 17, respectively, rewritten in independent form.

Claim 18 has been amended to define a fire alarm for performing the method of claim 13, comprising means for switching a testing mode and means for signaling an operational ability of the alarm.

Also in this amendment, the claims were amended to address the rejection under Section 112, second paragraph. Claims 14-17 have been amended to correctly claim "the method" of claim 13, rather than "a device".

The Applicants respectfully submit that the amendments to the claims to more clearly define the invention also make clearer the patentable distinctions over the cited reference combination.

The combination of the ~~Purt et al~~ and Deutsch et al patents provides no suggestion of the device and method of the present invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir 1992). In the present case, neither of the secondary references suggests the desirability of the modification proposed by the Examiner.

In addition, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 932, 933 (Fed Cir. 1984). The prior art of record fails to provide any such suggestion or incentive.


For the reasons set forth above, the Applicants respectfully submit that claims 1-20 are patentable over the cited art. The Applicants further request

withdrawal of the rejection under 35 U.S.C. 103 and reconsideration of the claims as herein amended.

In light of the foregoing arguments in support of patentability, the Applicants respectfully submit that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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